

REMARKS

Claims 1, 4, 6 and 7 have been amended to resolve issues raised by the Examiner under 35 U.S.C. 112. Support can be found in, e.g., the disclosure beginning at page 10, line 17 in the specification. Claims 8-10 have been added based on, e.g., page 21, lines 2-3 and Tables 2, 3, and 4 in the specification. The Abstract has been amended to resolve an issue raised by the Examiner.

Entry of the above amendment is respectfully requested.

Objection to the Abstract

On page 3 of the Office Action, in paragraph 3, the Examiner has objected to the Abstract because of the use of the legal term "comprising" in the second line.

In response, Applicants have amended the Abstract to change the word "comprising" to "including" to resolve this issue.

Accordingly, Applicants submit that this objection has been overcome, and withdrawal of the objection is respectfully requested.

Rejection under 35 U.S.C. 112, Second Paragraph

On page 3 of the Office Action, in paragraph 5, claims 1-7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Examiner's Position

(1) The claims are drawn to "an aqueous composition", but water is listed as one element of the "additive" Markush group in claim 1, and that recitation of "water" is redundant given that the composition is aqueous.

(2) With respect to the "additive" Markush group alternatives, claim 1 does not make clear whether "its salt" refers only to boric acid or to any of the additives that precede boric acid.

(3) With respect to claims 1-4 and 6-7, it is not clear what is meant by "a bivalent residue derived from thiazole" used to describe X in claims 1, 4, 6 and 7, and which "bivalent residue", other than the 1,3-thiazole moiety, would fall within the scope of the claims.

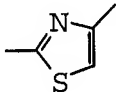
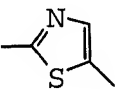
Applicants' Response

(1) To resolve the first issue raised by the Examiner, Applicants have amended the preamble of claim 1 to change "An aqueous composition" to "A composition".

Also, since the Examiner appears to be consider water as element of the "additive" Markush group, Applicants have moved the recitation of water to the location in claim 1 just before the recitation "and an additive selected from the group consisting of ...", thereby further clarifying that water should not be considered as an element of the "additive" Markush group.

(2) To resolve the second issue raised by the Examiner, Applicants have amended "boric acid or its salt" to "boric acid and a salt of boric acid". Thus, amended claim 1 makes clear that the salt is only a salt of boric acid.

(3) To resolve the third issue raised by the Examiner, Applicants have amended the claims based on the disclosure beginning at page 10, line 17 to recite that X is selected from the

group consisting of  and  and may be substituted.

Thus, Applicants submit that the amended claims satisfy the requirements of 35 U.S.C. 112, second paragraph, and withdrawal of this rejection is respectfully requested.

Rejection under 35 U.S.C. 112, First Paragraph

On page 4 of the Office Action, in paragraph 7, claims 1-4 and 6-7 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

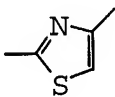
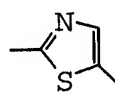
The Examiner's Position

The Examiner's position is basically that Applicants do not have sufficient written support for the phrase "a bivalent residue derived from thiazole" used to describe X in claims 1, 4, 6, and 7. In this regard, the Examiner indicates that all of the compounds disclosed in the tables of the specification contain the 1,3-thiazole moiety, or the 1,3-thiazole moiety with a substituent group attached to the 3rd ring C, and no other bivalent residue which has been derived from thiazole has been described. The Examiner indicates that while the present application has written description of 1,3-thiazole containing compounds and compounds identified in the specification tables and/or examples, the specification does not provide sufficient descriptive support for the myriad of compounds embraced by the claims.

Applicants' Response

In response, Applicants submit initially that a patent specification does not need to exemplify all or even any of the embodiments encompassed by a claimed invention, and thus the written description provided in the present application should not be considered inadequate due to the exemplification of compounds having a substituted or unsubstituted 1,3-thiazole moiety in particular without the exemplification of other compounds within the claim scope.

Nevertheless, to resolve this issue, Applicants have amended the claims to recite that X is

selected from the group consisting of  and  and may be substituted. With

this amendment, Applicants state that the specification, including the exemplified compounds, adequately supports the claimed invention.

Accordingly, Applicants submit that the present application satisfies the requirements of 35 U.S.C. 112, first paragraph, and withdrawal of this rejection is respectfully requested.

Anticipation Rejection

On page 8 of the Office Action, in paragraph 9, claims 1-7 are rejected under 35 U.S.C. § 102(e) as being anticipated by Inoue, et al. (WO 2004/067521 A1; priority date 2003 Jan 27; IDS 3/30/2007 reference).

The Examiner's Position

The Examiner's position is basically that Inoue teaches compounds of formula (I) (p. 4, starting at line 26), including the elected compound (p. 8, lines 31-32), solutions and suspensions (p. 27, line 33 - 28, line 1), and aqueous parenteral solutions and suspensions, which may contain additives, such as a glucose, which is a sugar (p. 28, lines 5, 7-11).

Applicants' Response

In response, Applicants note initially that claim 1 has been amended so that "sugar" is no longer recited as a member of the "additive" Markush group.

Thus, the definition of the additive is now recited as "an additive selected from the group consisting of polyol, sugar alcohol, boric acid and a salt of boric acid".

Accordingly, Applicants submit that the disclosure of glucose in Inoue neither teaches nor suggests the invention as recited in amended claim 1.

Further, Applicants have added dependent claims directed to glycerin, mannitol, and boric acid or its salt, based on the disclosure at page 21, lines 2-3 that especially preferred additives include glycerin, mannitol, boric acid or its salt, and based on the disclosure in Tables 2, 3, and 4 in the specification. Applicants submit that the disclosure of glucose in Inoue neither teaches nor suggests the invention as recited in these new claims.

Thus, Applicants submit that Inoue does not anticipate (or render obvious) the presently claimed invention, and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

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